

No Prior Art Cited

As an initial matter, Applicants submit that "**amazon.com**," as submitted by the Examiner in a 16-page printout of the Amazon.com web site, dated 28 January 2002, is *not* "*prior art*" as defined by 35 USC §102, and the mention of "Amazon.com opened its virtual doors in July 1995" in the printout fails to establish how amazon.com operated at that time.

Additionally, the rejection relies on Official Notice, but *fails to take Official Notice of any facts* that Applicants can traverse. Because "**amazon.com**" is not prior art and no Official Notice has been taken of any facts, Applicants submit that the rejection has failed to cite *any* prior art or facts upon which to make an obviousness rejection and respectfully requests allowance of the claims.

Incorrect Standard of Patentability Applied

The rejection is additionally improper since it has applied the incorrect standard of patentability. As quoted in the Office Action, the issue under 35 USC §103 is whether "the subject matter *as a whole* would have been *obvious*" (emphasis added). However, in the reasoned statement, the rejection repeatedly applies the incorrect standard with statements, such as:

- "the only 'arguable' limitation" is improper since it fails to consider the claim as a whole, see MPEP 2141.02;
- "There is nothing 'incredible' for this action" is improper since 35 USC §103(a) clearly states that patentability shall not be negated by the manner in which the invention was made;
- "those references determine that what the applicant is seeking to claim is not novel" is improper since obviousness, not novelty, is not the issue under 35 USC §103; and

- "there is nothing novel of deriving this configuration" is improper since, again, obviousness, not novelty, is not the issue under 35 USC §103.

In view of the above, the remainder of the remarks will treat an obviousness rejection of the claims over U.S. Patent Nos. 5,715,399 and 5,727,163 (hereinafter Bezos '399 & '163) in view of well-known use of the Internet for communication and transactions.

Failure to Make a Prima Facie Case of Obviousness

In addition, to establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. (See M.P.E.P. Section 2143).

No Motivation to Combine

In the present case, the Office Action has failed to satisfy at least the first and third criteria. First, there is no suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify Bezos '399 or '163 to include an information server separate from the merchant computer, let alone the additional email-invoked functionality claimed by Applicants.

Bezos '399 and '163 disclose systems in which a merchant server collects and stores payment information (i.e., name, address, and credit card number that make up the typical "wallet"). The advantage to the consumer is that confidential information is not repeatedly transmitted over the Internet. However, the consumer is now limited to dealing with that particular merchant (i.e., Amazon.com), which is considered as a benefit to the merchant. Indeed,

an inherent purpose of Bezos '399 and '163 (see statements referring to repeat purchases) and the explicit purpose of the business model of Amazon.com, especially in its 1-click embodiment, is to have the merchant (Amazon.com) maintain the consumer's wallet so that the consumer finds it easier to shop at Amazon.com than at other merchants.

Therefore, any modification of Bezos '399 or '163 (or Amazon.com) to include an information server separate from the merchant server would render the invention unsatisfactory for the intended purpose of the Amazon.com-related inventions to bring and lock customers into Amazon.com (see MPEP 2143.01 discussion related to any proposed modification rendering the prior art invention being modified unsatisfactory for its intended purpose) by allowing the customer to shop with ease *elsewhere* using an "agile" wallet provided by the separate information server. As such, there is no motivation to modify Amazon.com-related inventions to include use of an information server.

All Claim Limitations Not Shown

With respect to independent claim 1, and claims 2- that depend therefrom, the cited references at least lack disclosure to: "at least one consumer information server further comprises consumer information server software, wherein the consumer information server software further comprises instructions for forwarding an email message to the at least one consumer computer, and wherein the email message further comprises the proper links for connecting the consumer's web browser to the consumer information server to allow the at least one consumer to begin a registration process;"

With respect to independent claim 5, and claims 6-10 that depend therefrom, the cited references at least lack disclosure to: "merchant computer ...software ...for forwarding an email message to the at least one consumer computer, wherein the email message further comprises the

proper links for connecting the consumer's web browser to a consumer information server to allow the at least one consumer to begin a registration process;"

With respect to independent claim 11, and claims 12-17 that depend therefrom, the cited references at least lack disclosure to: "at least one consumer information server further comprises consumer information server software and at least one consumer information datastructure comprising consumer information associated with at least one consumer, wherein the at least one consumer uses the web browser to access the consumer information datastructure via the consumer information server and the network to obtain consumer information which is associated with the at least one consumer;"

With respect to independent claim 18, and claims 19-20 that depend therefrom, the cited references at least lack disclosure to: "sending an email message over a network, wherein the email message comprises the proper links for connecting at least one consumer computer to at least one consumer information server" in a system with a merchant computer;

With respect to independent claim 21, and claims 22-34 that depend therefrom, the cited references at least lack disclosure to: "accessing the consumer information stored in a consumer data structure on the consumer information server; and displaying the consumer information to the consumer using the consumer's web browser" in a system with a merchant computer;

With respect to independent claim 35, and claims 36-40 that depend therefrom, the cited references at least lack disclosure to: "at least one information server connected to the at least one accessee computer via the network and to the at least one accessor computer via the network, wherein the at least one information server further comprises information server software, wherein the information server software further comprises instructions for forwarding an email message to the at least one accessee computer, and wherein the email message further comprises

the proper links for connecting the accessee's web browser to the information server to allow the at least one consumer to begin a registration process;"

With respect to independent claim 41, and claims 42-47 that depend therefrom, the cited references at least lack disclosure to: "accessor computer ...software ...for forwarding an email message to the at least one accessee computer, wherein the email message further comprises the proper links for connecting the accessee's web browser to an information server to allow the at least one accessee to begin a registration process;"

With respect to independent claim 48, and claims 49-56 that depend therefrom, the cited references at least lack disclosure to: "at least one information server further comprises information server software and at least one accessee information datastructure comprising accessee information associated with at least one accessee, wherein the at least one accessee uses the web browser to access the accessee information datastructure via the information server and the network to obtain accessee information which is associated with the at least one accessee;"

With respect to independent claim 57, and claims 58-59 that depend therefrom, the cited references at least lack disclosure to: "sending an email message over a network, wherein the email message comprises the proper links for connecting at least one accessee computer to at least one information server; invoking a connection between the at least one accessee computer and the at least one information server using the proper links in the email message; connecting the at least one accessee computer to the at least one information server; invoking a registration process in the information server software; prompting the accessee for registration information; and saving the registration information from the accessee"

With respect to independent claim 60, and claims 61-73 that depend therefrom, the cited references at least lack disclosure to: "establishing accessee information associated with an

accesses in an access data structure in the at least one information server; accessing the access information stored in the access data structure on the information server; and displaying the access information to the access using the access's web browser;"

With respect to independent claim 74, and claims 75-76 that depend therefrom, the cited references at least lack disclosure to: "merchant computer ... software ... sends at least one email message to at least one consumer computer wherein the at least one email message comprises at least one merchant offer and proper links for connecting the consumer's web browser to the consumer information server whereby allowing the at least one consumer to complete a purchasing transaction;"

With respect to independent claim 77, the cited references at least lack disclosure to: "sending an email message from a merchant computer to at least one consumer computer, wherein the email message is sent over a network, the email message comprising at least one merchant's offer and proper links for connecting the consumer's web browser to the consumer information server; invoking a connection between the at least one consumer computer to at least one consumer information server using the proper links in the email message; and connecting the at least one consumer computer to the at least one consumer information server whereby allowing the at least one consumer to complete a purchasing transaction;"

With respect to independent claim 78, the cited references at least lack disclosure to: "merchant computer ... software ... for gathering purchasing information from the at least one consumer and for allowing the at least one merchant to send and receive information over the network, and wherein the merchant ... software gathers purchasing information from the at least one consumer, forwards the consumer's purchasing information to the consumer information

server if the consumer elects to become a registered consumer, and connects the consumer to the CIS;" and

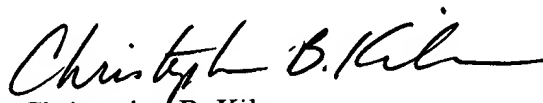
With respect to independent claim 79, the cited references at least lack disclosure to: "sending the gathered purchasing information and proper links for connecting at least one consumer computer to at least one consumer information server if the consumer elects to become a registered consumer; invoking a connection between the at least one consumer computer to at least one consumer information server using the proper links; connecting the at least one consumer computer to the at least one consumer information server; invoking a registration process in the at least one consumer information server; prompting the consumer for registration information; and saving the registration information from the consumer."

In view of the above arguments, Applicant respectfully submits that claims 1-79 are novel and non-obvious over the cited prior art.

Conclusion

For the reasons cited above, Applicants submit that claims 1-79 are in condition for allowance and requests reconsideration of the application. If there remain any issues that may be disposed of via a telephonic interview, the Examiner is kindly invited to contact the undersigned at the local exchange given below.

Respectfully submitted,



Christopher B. Kilner
Registration No. 45,381
Roberts Abokhair & Mardula, LLC
11800 Sunrise Valley Drive, Suite 1000
Reston, VA 20191-5302
(703) 391-2900